

REMARKS

Applicants submit this Reply in response to the Final Office Action mailed on May 22, 2008. Claims 46-79 and 83-87 remain pending in this application, of which claim 84 is the sole independent claim.

In the Office Action, the Examiner rejected claims 46-62, 73, 75-79, and 83-85 under 35 U.S.C. § 103(a) as being unpatentable over an IEEE Publication ("Meurer") in view of WO 98/52197 ("Belli '197"); rejected claims 62, 63, 69-72, and 84 under § 103(a) as being unpatentable over Meurer in view of WO 99/33070 ("Belli '070"); and rejected claims 64-68, 74, 84, and 86-88 under § 103(a) as being unpatentable over Meurer in view of U.S. Pat. Pub. No. 2005/0046073 ("Balconi").

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner rejected claims 46-62, 73, 75-79, and 83-85 as being unpatentable over Meurer in view of Belli '197; rejected claims 62, 63, 69-72, and 84 as being unpatentable over Meurer in view of Belli '070; and rejected claims 64-68, 74, 84, and 86-88 as being unpatentable over Meurer in view of Balconi. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art

elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, neither Meurer, Belli '197, Belli '070, Balconi, nor their combination, teach or suggest every feature of Applicants' claims. Specifically, none of the references cited by the Examiner, nor their combination, teach or suggest the method recited in independent amended claim 84, namely the step of “determining a correlation between a thickness of said protective element and a thickness of said insulating layer so as to ensure the safe operation of the cable in the selected voltage class on said selected conductor cross-sectional area and that the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J.”

In the Office Action, the Examiner asserts that Meurer discloses “determining a correlation between a thickness of the protective element and a thickness of the insulating layer.” Office Action at 3. However, Applicants can find no support in the reference for the Examiner's contention, nor does the Examiner provide any citation to a particular passage of Meurer. Meurer appears only to teach the reduction in the thickness of insulation layers in cables in light of recent improvements in the materials used for that layer. It does not appear that Meurer anywhere discloses “determining a correlation between a thickness of the protective element and a thickness of the insulating layer.” In fact, regarding a protective element, Meurer only mentions that “shields have improved continuously over the past decades” on page 823.

Further, Meurer states that insulation layer thicknesses “should be changed by more focus on the AC breakdown strength before and after accelerated ageing under

wet conditions instead of geometrical dimensions.” Meurer at 823. But Independent claim 84 recites “determining a correlation between a thickness of said protective element and a thickness of said insulating layer so as to ensure . . . that the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J.” Meurer does not appear to disclose anything regarding a cable’s impact resistance and, thus, does not teach “a correlation between a thickness of said protective element and a thickness of said insulating layer so as to ensure . . . that the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J.”

Additionally, none of the other references cited by the Examiner appears to disclose “determining a correlation between a thickness of said protective element and a thickness of said insulating layer,” nor does the Examiner suggest that they do. As a result, the references as combined by the Examiner in the Office Action fail to teach or suggest that step, recited in independent claim 84.

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of independent claim 84 under 35 U.S.C. § 103(a) as being unpatentable over Meurer in view of either Belli '197, Belli '070, or Balconi.

Moreover, claims 46-79, 83, and 85-87 depend from independent claim 84 and, thus, contain all the elements and recitations thereof. As a result, dependent claims 46-79, 83, and 85-87 are allowable at least due to their corresponding dependence from independent claim 84.

Examiner’s § 103(a) Rejection Based On Balconi

As discussed above, the Examiner, in the Office Action, rejected claims 64-68, 74, 84, 86, and 87 under 35 U.S.C. § 103(a) as being unpatentable over Meurer in view

of Balconi. However, the Examiner admits that Balconi appears to only be available as prior art under 35 U.S.C. § 102(e) and, thus, can only be properly considered in a rejection under § 103(a) if it is not disqualified as prior art under § 103(c).

35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added).

Applicants hereby assert that, at the time the claimed invention was made, both the present application and Balconi were subject to an obligation of assignment to Pirelli & C. S.p.A.

Accordingly, under § 103(c), Balconi cannot be applied as prior art to reject claims of the present application under 35 U.S.C. § 103(a). As a result, Applicants request the Examiner reconsider and withdraw the rejection of claims 64-68, 74, 84, 86, and 87 under § 103(a).

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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